

REMARKS

Claims 1-4 and 8-13 are pending.

The amendments to claim 1 have been made to delete non-elected subject matter. Thus, the amendments are made in response to the Restriction Requirement, not for patentability purposes.

The amendments to the preambles of claims 2-4 have been made for cosmetic reason and would not narrow the scope of the claim because it would have been apparent to one skilled in the art that, in these dependent claims, “[a] compound of general formula described in claim 1” naturally have the R groups and n as defined in claim 1 unless otherwise specified, so “[a] compound of claim 1” and “[a] compound of general formula described in claim 1” have the same practical meaning.

The amendment to claim 9 would not narrow the scope of the claim because claim 9 is rendered broader by the amendment.

Restriction Requirement

Claims 2-4 were withdrawn from consideration because the Examiner alleged that these claims cover non-elected subject matter. Applicants respectfully disagree because the R groups and n in claims 2-4 naturally have the same definitions as in claim 1 unless otherwise specified, so claims 2-4 cover no more than what claim 1 covers. Since claim 1 covers only elected subject matter, with the amendment of the preambles of claims 2-4 to read “compound of claim 1”, applicants submit that claims 2-4 should be examined on the merits.

Rejection under 35 USC §112, first paragraph

Claim 9 was rejected as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicants respectfully traverse the rejection.

The Office took a position that a pharmaceutical composition for treating cancer was not enabled by the *in vitro* data which shows growth inhibition of carcinoma cells and of leukemia cells. Applicants respectfully disagree. The Office also took a position that *In re Brana*, 34 USPQ2d 1436 is limited to only compound claims, not composition claims. *In re Brana* held that the novel compounds of the invention at issue there were enabled by *in vitro* data showing cytotoxicity in cancer cells (US 5,552,544, the patent at issue in *In re Brana*, disclosed that the novel compounds were useful as “antitumor substances”, column 1, lines 35-36, and the only biological data disclosed were cytotoxicity data of the compounds against tumor cells *in vitro*; column 2, lines 44-46). Thus, *In re Brana* held that the *in vitro* data in tumor cells enabled the antitumor uses of the novel compounds. Since the composition of claim 9 comprises the compound of claim 1 and a pharmaceutically acceptable carrier, and since the compound of claim 1 is the only active ingredient required in the composition, with the fact that the compounds of claim 1 are enabled by the disclosures of the present specification as antitumor, it naturally follows that the composition of claim 9 is also enabled for treating cancer. Withdrawal of the rejection is requested.

Applicants submit that claim 13 is enabled by the disclosure in the specification because page 51, lines 1-1 and Table 4 at pages 52-53 show that the compounds of claim 1 are effective in inhibiting the growth of tumor cells.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1 and 8-12 were rejected as indefinite concerning R₆ representing something as “hereinafter described.” The phrases “hereinafter described” concerning R₆ have been deleted from claim 1, which should render the rejection moot. Withdrawal of the rejection is requested.

Rejection of Claim 1 under 35 U.S.C. § 102

Claim 1 was rejected under 35 U.S.C. § 102(a) as being anticipated by Crews (*J. Org. Chem.* 59, 2932, 1994). Applicants respectfully traverse the rejection.

Crews discloses the compound designated milnamide A, which corresponds to a compound of formula I as follows:

R₆ is a methine group bonded to the indole group, forming a 6-membered ring;

R₁ is methyl; and

R₇₅ is -CH(iPr)-CH=CH(Me)-COOH.

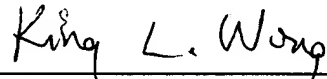
When R₆ is bonded to the indole group forming a 6-membered ring, the compound of formula I is tricyclic. However, tricyclic compounds under formula I were non-elected subject matter excluded by claim 1. Thus, Crews fails to anticipate claim 1, which does not cover milnamide A. Withdrawal of the anticipatory rejection is requested.

Conclusion

In view of the amendment and the above reasoning, applicants submit that the application is in a condition for allowance. A Notice of Allowance is believed in order.

In the event that the filing of this paper is not deemed timely, applicants petition for an appropriate extension of time. Any petition fee for the extension of time and any other fees that may be required in relation to this paper can be charged to Deposit Account No. 01-2300, referencing Docket No. 108281-00001.

Respectfully submitted,



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